



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,780	11/16/2001	John J. Daniels	14531.71.4.3	1576

22913 7590 07/23/2003

WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER &
SEELEY)
60 EAST SOUTH TEMPLE
1000 EAGLE GATE TOWER
SALT LAKE CITY, UT 84111

EXAMINER

LEE, Y YOUNG

ART UNIT	PAPER NUMBER
----------	--------------

2613
DATE MAILED: 07/23/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/993,780	Applicant(s) John J. Daniels
	Examiner Y. Lee	Art Unit 2613
		
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>		
Period for Reply <p>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</p> <ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). 		
Status <p>1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>May 5, 2003</u></p> <p>2a) <input type="checkbox"/> This action is FINAL. 2b) <input checked="" type="checkbox"/> This action is non-final.</p> <p>3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11; 453 O.G. 213.</p>		
Disposition of Claims <p>4) <input checked="" type="checkbox"/> Claim(s) <u>3-8, 13-15, 27-30, and 37-63</u> is/are pending in the application.</p> <p>4a) Of the above, claim(s) _____ is/are withdrawn from consideration.</p> <p>5) <input type="checkbox"/> Claim(s) _____ is/are allowed.</p> <p>6) <input checked="" type="checkbox"/> Claim(s) <u>3-8, 13-15, 27-30, and 37-63</u> is/are rejected.</p> <p>7) <input type="checkbox"/> Claim(s) _____ is/are objected to.</p> <p>8) <input type="checkbox"/> Claims _____ are subject to restriction and/or election requirement.</p>		
Application Papers <p>9) <input type="checkbox"/> The specification is objected to by the Examiner.</p> <p>10) <input checked="" type="checkbox"/> The drawing(s) filed on <u>May 5, 2003</u> is/are a) <input checked="" type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).</p> <p>11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.</p> <p>12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.</p>		
Priority under 35 U.S.C. §§ 119 and 120 <p>13) <input type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) <input type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of: 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</p> <p>*See the attached detailed Office action for a list of the certified copies not received.</p>		
<p>14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e). a) <input type="checkbox"/> The translation of the foreign language provisional application has been received.</p> <p>15) <input checked="" type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.</p>		
Attachment(s) <p>1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____</p> <p>4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: _____</p>		

Art Unit: 2613

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/5/03 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Art Unit: 2613

3. Claims 3-8, 13-15, 27-30, and 37-63 are rejected under 35 U.S.C. 102(e) as being anticipated by Chan et al (5,553,123).

Chan et al, in Figures 77 and 79-84, discloses the same interactive television system that includes a computing system and a recording device that is configured to record television programs as specified in claims 3-8, 13-15, 27-30, and 37-63 of the present invention, wherein the interactive television system is connectable by means of the computing system to a server 1522 that is connectable to a network (Fig. 82), a method for enabling the server 1522 to control the recording of one or more selected television programs 1550 by the interactive television system, the method comprising the acts of receiving at the server 1522 a request from a computing system of an interactive television system for a programming schedule 1526 that identifies one or more television programs; in response to the request, the server 1522 providing the programming schedule 1526 to the computing system of the interactive television system; receiving at the server 1522 an identification (e.g. G-codes) provided from the computing system of the interactive television system of one or more television programs to be recorded, the one or more television programs to be recorded having been selected at the computing system of the interactive television system from the programming schedule 1526 provided from the server 1522; and in response to the programs identified for recording, the sever 1522 automatically and independently of any broadcast signal for audio visual programming content, downloading recording instructions (e.g. date, time, etc.) to the computing system of the

Art Unit: 2613

interactive television system so that the recording device 1550 will thereafter, automatically and without user intervention, be set up to record the one or more selected television programs.

With respect to claims 3-8, 13-15, 27-30, 38-43, 45-49, 51-57, and 59-63, Chan et al also discloses receiving, from the remote device 1522, information representing a television signal provider (e.g. channel name) that is to broadcast the one or more television programs to be recorded by the interactive television system, wherein the television signal provider has been selected at the remote device in response to input received at the remote device 1522; prior to the act of receiving information representing a television signal provider, the act of transmitting, to the remote device 1522, information 1526 identifying a plurality of television signal providers that are capable of broadcasting television programs to the interactive television system; wherein the server communicates with the remote device through an internet connection; the programming schedule 1526 includes a time, date and duration CDTL of the one or more television programs that are to be recorded; the programming schedule 1526 include transmission source information (e.g. G-codes) that enables the interactive television system to tune to one or more signals in which the one or more television programs are encoded; and the transmission source information identifies at least one of a television broadcast channel, a cable channel (e.g. HBO), and a satellite channel through which the one or more signals is to be received by the interactive television system.

Art Unit: 2613

Response to Arguments

4. Applicant's arguments with respect to claims 3-8, 13-15, 27-30, and 37-63 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications intended for entry)

(for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Or:

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).

Art Unit: 2613

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Y. Lee whose telephone number is (703) 308-7584.



Y. LEE
PRIMARY EXAMINER

Y. Lee/y1
July 21, 2003